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PATENT APPLICATION

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In re application of

Docket No: Q59644

Kazuhiko OHGA, et al.

Appln. No.: 09/582,495

Group Art Unit: 1625

Confirmation No.: 8756

Examiner: H. Reyes

Filed: June 27, 2000

For: PROCESS FOR PRODUCING HYDROGENATED ESTER, HYDROGENATING CATALYST USED THEREFOR AND PROCESS FOR PRODUCING THE CATALYST

**STATEMENT OF SUBSTANCE OF EXAMINER INTERVIEW
AND REQUEST FOR ENTRY OF AMENDMENT FILED SEPTEMBER 3, 2002
AND A NEW OFFICE ACTION**

Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants thank Examiner Hector Reyes and Supervisory Patent Examiner Alan Rotman for the courtesies extended during the Interview conducted on January 14, 2003. This Statement is submitted as a summary of the substance of the Interview conducted on January 14, 2003 and as a formal request for entry of the Amendment filed on September 3, 2002 and a new Office Action and time period for response in view of the Advisory Action mailed on October 8, 2002, and the Examiner's decision to withdraw the finality of the Office Action dated June 3, 2002, as indicated in the Interview Summary.

Status of the Application

In this case a final Office Action was issued on June 3, 2002, in which claims 4, 6-13 and 24-34 were pending. In the Office Action, claims 9, 24-31 and 33 were allowed; claims 4, 6-8, 10, 32 and 34 were rejected; and claims 11-13 were objected to. Claims 4, 6, 7 and 8 were rejected under 35 U.S.C. § 112, 2nd paragraph, as dependent upon a cancelled claim; claim 10 was rejected under 35 U.S.C. § 112, 2nd paragraph as indefinite for failure to provide a definition

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of "allyl-type ester" and chemical formula (3) recited therein; and claims 32 and 34 were rejected under 35 U.S.C. § 112, 2nd paragraph, as containing a narrow statement of the broad range of catalyst in the same claim. Claims 11-13 were objected to as dependent upon a rejected claims, namely claim 10.

Applicants filed an Amendment on September 3, 2002, amending claims 4, 6-8, 32 and 34 in response to the rejections under 35 U.S.C. § 112, 2nd paragraph. Claims 4, 6, 7, and 8 were amended to depend from claim 30, thereby obviating the rejection under 35 U.S.C. § 112, 2nd paragraph; claim 10 was amended by replacing "allyl-type ester" with "unsaturated group containing ester" and to include formula (3), thereby obviating the rejection under 35 U.S.C. § 112, 2nd paragraph; and claims 32 and 34 were amended to recite "wherein the hydrogenating catalyst comprises at least one species selected from the group consisting of palladium, ruthenium and rhodium", thereby obviating the rejection under 35 U.S.C. § 112, 2nd paragraph.

In a subsequent Advisory Action dated October 8, 2002, the Examiner indicated that the proposed amendments would not be entered because they raised new issues that required further consideration and/or search and they were not deemed to place the application in better condition for allowance. In the Note the Examiner stated:

There is a deficiency in the definition of the invention as described in the amended claims that raises new issues upon 35 U.S.C. § 112, first and second paragraph. For example, the use of alternative conditions in the starting material use as described in proposed claim 4, multiple use of the phrase "general formula" in different claims, the extraordinary extensive list of possible catalysts as described in claim 8, the use of the word species on proposed claims 31 and 32, etc. Regarding the general description of the catalyst it is not clear if such catalyst is a metal in the elementary form or is a compound containing a metallic element. Moreover, such description is vague and indefinite and could be rejected based on the lack of enablement because catalyst are highly unpredictable. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400 (1988) and *Ex parte Sixto*, (Bd. Pat. App. & Int.) 9, USPQ2d 2081.

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Applicants subsequently filed a Notice of Appeal and requested an Interview with the Examiner and his supervisor. The Interview was conducted on January 14, 2003, in which the issues raised in the Advisory Action were discussed. All pending claims and the issues raised in the Advisory Action were discussed.

Applicants' Position

Applicants submitted that the Amendments to the claims did not necessitate the alleged new issues asserted by the Examiner.

In regard to the Examiner's assertion regarding the use of alternative conditions in the starting material in claim 4, Applicants pointed out that claim 4 was amended by changing its dependency from claim 3 to claim 30 and therefore no new issue was presented that could not have been previously considered by the Examiner. Further, it was pointed out that the phrase "corresponding hydrogenated ester" in claim 4 refers to the inert solvent recited in claim 30, which recites "wherein the inert solvent is the corresponding ester" and not to the starting material.

In regard to the assertion that the multiple use of the phrase "general formula" in different claims raised new issues, it was pointed out that the phrase "general formula" had not been changed since the application was originally filed on June 27, 2002, and no previous rejection was raised with respect to this term in the previous three (3) Office Actions. Therefore it is improper to state the phrase is indefinite and raises new issues that required further search and consideration in an Advisory Action after final rejection.

In regard to the assertion that claim 8 described an "extraordinary extensive list of multiple catalyst," it was pointed out that claim 8 was amended by changing its dependency from claim 3 to claim 30 and the word "or" was changed to "and" to correct improper Markush language which is readily apparent and did not raise new issues or describe an "extraordinary extensive list of multiple catalyst" especially since claim 8 further narrowed the hydrogenating catalyst described in claim 30, which was indicated as allowed.

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In regard to the use of the word "species" in claims 32 and 34, it was pointed out that the word "species" was not newly introduced in the Amendment filed on September 3, 2002, and was unchanged from the original introduction of the claims in the Amendment filed on October 5, 2001, and no previous rejection was made with respect to the use of the word "species" in the previous two (2) Office Actions. Therefore, it is improper to state that the use of the word "species" raises new issues that require further search and consideration in an Advisory Action after a final rejection.

Applicants further argued that no previous rejection had been made based on a lack of enablement and that if the Examiner wished to raise such a new ground of rejection then it would be proper to withdraw finality of the Office Action dated June 3, 2002 and reopen prosecution.

The Examiner's Position

During the interview, the Examiner indicated that favorable consideration would be given to the following proposed claim amendments:

1. deletion of the word "general" in the phrase "general formula";
2. deletion of the word "species" as used in the phrase "at least one species" in the claims; and
3. amending claim 4 to recite "the process for producing a hydrogenated ester according to claim 30, wherein the inert solvent is the corresponding hydrogenated ester and is a portion or the entirety of ~~the a~~ recycled hydrogenated ester"

With respect to the issue of enablement, the Examiner's position appears to be that the claims are allegedly not enabled for all hydrogenating catalysts as recited in independent claims 10 and 30 or a "hydrogenating catalyst which contains at least one metal selected from the group consisting of Group VIII elements, Group IX elements, and Group X elements in the periodic table" as recited in independent claims 31 and 33, but are only enabled for palladium, rhuthenium and rhodium, in view of the unpredictability of catalysts. The Examiner further cited

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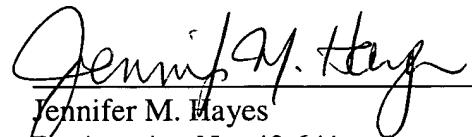
In re Sizto, 9 USPQ2d 2081 (Bd. Pat. App. & Int. 1988) in support of his contention. The Examiner also indicated that favorable consideration would be given to amending the independent claims to recite palladium, rhuthenium and rhodium as the hydrogenating catalyst used in the claimed process.

The Examiner agreed to withdraw finality of the Office Action, See Interview Summary.

In view of the summary above and in view of the fact that the Examiner has agreed to withdraw finality of the Office Action dated June 3, 2002, Applicants respectfully request:

1. Entry of the Amendment filed on September 3, 2002;
2. A new Office Action setting forth the basis for the Examiner's new rejections and assertions, particularly with respect to the alleged lack of enablement for the element of the hydrogenating catalyst in the claims; and
3. A new time period for Applicants to reply thereto.

Respectfully submitted,



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